

REMARKS

The applicant thanks the examiner for the interview of April 30, 2009. At the interview, proposed amendments to the independent claims (which had been provided to the examiner and her supervisor prior to the interview) and the universal payment identification code system (UPIC) described in "Cracking the Code," Eric Winig, Washington Business Journal were discussed. The examiner's supervisor referred the applicant to and described a United Way/Combined Federal Campaign system (United Way/CFC).

The comments of the applicant below are each preceded by related comments of the examiner (in small, bold type).

2. Claims 1-35, 138 and 139 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
3. In order for a method to be considered a "process" under § 101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under 5 10 1 and is non-statutory subject matter. An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state. See *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

Claim 1 has been amended. Claims 138 and 139 have been canceled.

2. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wells et al., U.S. PG-Pub No. 2003/0110136 (reference A on the attached PTO-892) in view of Winig, "Cracking the Code" (reference U on the attached PTO-892).
3. As per claim 1, Wells et al. teaches a method comprising maintaining a financial account that represents value, on behalf of an account holder, the financial account having a plurality of account identifiers that in the account, or a party that presents a general account identifier to effect both debit and credit transactions in the account (see paragraph 0016, lines 5-10 and paragraph 0017, lines 2-6). Wells et al. fails to teach enabling a third party to effect a credit transaction in the account by presenting a credit identifier, which is an identifier different from the debit or general account identifiers, the credit identifier

simultaneously carrying account information capable of identifying the financial account, and transaction information indicating that the credit identifier is insufficient to enable a third party to effect a debit transaction in the account, the account information being inseparable from the transaction information in the credit identifier. Winig teaches enabling a third party to effect a credit transaction in the account by presenting a credit identifier, which is an identifier different from the debit or general account identifiers, the credit identifier simultaneously carrying account information capable of identifying the financial account, and transaction information indicating that the credit identifier is insufficient to enable a third party to effect a debit transaction in the account, the account information being inseparable from the transaction information in the credit identifier (see paragraphs 5-7). The Examiner recognizes that since the system is only set up to process credit transactions, then when a debit transaction is attempted the system will indicate that debiting is not possible. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the method of Wells et al. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of eliminating the necessity of revealing bank information to customers and therefore would remove a big obstacle to doing business with previously unknown firms (see paragraph 8 of Winig).

Amended claim 1 recites that a “financial institution to which the credit-only unique identifier is presented [is] able, without requiring more information than the credit-only unique identifier, to obtain a corresponding unprotected reference to [a] financial institution that maintains [a] related financial account and to route [a] credit-only transaction towards the financial institution that maintains the related financial account for processing as a credit-only transaction, but not to obtain private information about the account holder without permission of the financial institution that maintains the financial account.”

In Winig, a payer could use a UPIC identifier of a company or an individual to pay into an account of the company or an individual. The UPIC identifier is said to hide “all of the company’s or individual’s information from the [payer].” (paragraph 5) For example, in the UPIC system, “a utility firm could give its UPIC [identifier] to its consumers, who would then authorize a payment.” The payer “would need only to know the UPIC; he or she would never see the firm’s account or routing numbers.” (paragraph 6)

However, while—according to Winig—the *payer* that used a UPIC might not need to know and would not see the firm’s account or routing numbers, there is simply nothing in the cited passages of Winig or Wells, taken alone or together, that describes or would have made obvious that the *financial institution to which the UPIC is presented* could, without requiring more information than the UPIC, *obtain a corresponding unprotected reference* to the financial

institution that maintains the firm's financial account and route the transaction towards that financial institution for processing as a credit-only transaction, *while not obtaining private information about the account holder without permission of the financial institution that maintains the financial account,*" as recited in applicant's claim 1.

Based on the comments at the interview about United Way/CFC, the applicant located information (cited on the attached form PTO SB/08) concerning the United Way/CFC system, which is described as

... the only authorized solicitation of Federal employees in their workplaces on behalf of approved charitable organizations.

The CFC [enables]... a Federal donor ... to make charitable contributions through payroll deduction. ("What is CFC?," 2008 CFCNCA Catalog of Caring, hereinafter "the Catalog")

The Catalog includes a "Charity List ... of national, international, and local organizations that have met CFC eligibility requirements." (page 2, "The Charity List") A sample charity listing is reproduced below:

Sample Charity Listing

11405 ABC Charity (Alpha-Charity) (800)555-5555 www.abccharity.org EIN#12-3456789 ABC Charity attacks the causes of hunger and poverty by promoting effective and innovative community-based solutions that create self-reliance, economic justice, and food security. 15.8% P,S,K

As shown in the sample charity listing, the ABC charity is assigned a five-digit CFC code (in this case, "11405"). To make a donation to a charity, the donor specifies the donation amount and designates all or a portion of his donation to the charity by "[recording] that [charity's] corresponding five-digit [CFC] code number on [a] pledge form." (page 3, "How do I designate a federation, or alternatively one of its members, to receive my contribution?")

According to the "How to make a gift" section of the Catalog, the donor adds up all individual donations and makes out a check, or authorizes another payment method, for the total sum. (page 148) United Way/CFC then, "distributes all contributions ... as designated." (page 3, "Can I specify which organization will receive my contribution?")

Thus, United Way/CFC "solicits contributions [from donors] on behalf of approved charities" (page 2, "What is CFC?") and "[distributes] all contributions to the charities [designated

by the donors].” (page 3, “Can I specify which organization will receive my contribution?”)

The applicant disagrees that this United Way/CFC system anticipated or would have made obvious what is recited in the applicant's claim 1. The applicant infers from the references it located that (a) the payee of the donor's payment is the United Way/CFC itself, (b) the charity codes merely enable the donor to provide an unambiguous identification of the target charities, (c) that the United Way/CFC deposits the donor payments to its own bank account, aggregates the donations directed to the respective charities and draws its own payments on its own account to each of those charities and presents them to the charities, which then clear them through the standard payment clearance system. If the applicant's inferences are correct, the United Way/CFC system uses conventional payment and clearance techniques, and is fundamentally different from (and would not have made obvious) what is recited in claim 1. For example,

1. the charity codes are not credit-only identifiers of accounts, because the United Way/CFC is not a financial institution that maintains financial accounts for the charities; the United Way/CFC is only a conduit for payments, not a financial institution that maintains financial accounts for charities.

2. even if, contrary to a reasonable construction of claim 1, the charity codes were to be construed as credit-only identifiers, they are not unique “across a group of financial institutions,” but are only used by a single institution, the United Way/CFC.

3. even if, contrary to a reasonable construction of claim 1, the charity codes were to be construed as credit-only identifiers of financial accounts maintained by the United Way/CFC, those financial accounts do not have “other account identifiers.”

4. assuming the donor could be a “third party” in claim 1, the “credit transaction” being initiated by the donor is represented by the conventional check or payment to the United Way/CFC and the code numbers of the charities. The credit transaction is thus not directed to “financial accounts maintained on behalf of” the charities. Rather the credit transaction is directed to an account of the United Way/CFC in its bank account.

5. in any case, the donor's credit transaction can only be directed to the United Way/CFC and not to one of multiple “financial accounts maintained on behalf of” some party.

6. the United Way/CFC knows in advance the identity of the charities to which its payments are to be made and may well have routing information to the accounts of those

charities. Thus, there is no need and it would not have been obvious for the United Way/CFC to be (in the words of claim 1) "able, without requiring more information than the credit-only unique identifier, to obtain a corresponding unprotected reference to the financial institution that maintains the related financial account and to route the credit-only transaction towards the financial institution that maintains the related financial account for processing as a credit-only transaction, but not to obtain private information about the account holder without permission of the financial institution that maintains the financial account."

For at least some similar reasons as those explained for claim 1, amended claim 21 is also patentable over the prior art.

4. As per claim 2,

5. As per claim 3,

6. As per claim 4,

7. As per claim 5,

...

8. As per claim 19, Winig teaches a method comprising maintaining a financial account that represents value, on behalf of an account holder (see paragraph 10), and effecting a credit transaction in the account in response to an identification of the financial account and an indication that the identification is insufficient for the third party to effect a debit transaction in the account (see paragraphs 5-7). The Examiner recognizes that since the system is only set up to process credit transactions, then when a debit transaction is attempted the system will indicate that debiting is not possible.

Amended claim 19 recites that the transaction processing party can determine "from all or a portion of the credit-only transaction identifier, and needing no more than the credit-only transaction identifier to determine, that the credit-only transaction identifier relates to a credit-only transaction and is of a type that is recognized and accepted for effecting credit-only transactions by a group of financial institutions in financial accounts maintained by the financial institutions for their account holders."

There is nothing in Winig, Wells, or the United Way/CFC system, taken alone or together, that describes or would have made obvious at least this feature of applicant's claim 19.

With respect to the United Way/CFC system, as understood by the applicant:

1. even if the donation payment and the charity codes provided by the donor to the United Way/CFC were construed to be a "proposed credit-only transaction," it would be a credit-only transaction in the bank account of United Way/CFC, not in a financial account of the charity maintained in a financial institution.

2. the United Way/CFC knows in advance that the proposed transaction by the donor is a credit-only transaction, and therefore does not determine "from all or a portion of the credit-only transaction identifier, and needing no more than the credit-only transaction identifier to determine, that the credit-only transaction identifier relates to a credit-only transaction."

3. the United Way/CFC never determines that the donor's proposed credit-only transaction is "of a type that is recognized and accepted for effecting credit-only transactions by a group of financial institutions in financial accounts maintained by the financial institutions for their account holders."

4. nor could it make such a determination, because in the United Way/CFC system the donor's transaction is not one that is "recognized and accepted for effecting credit-only transactions by a group of financial institutions in financial accounts maintained by the financial institutions for their account holders."

9. As per claim 20, Winig teaches a method comprising maintaining, at a financial institution, a financial account for a merchant (see paragraph 10), the financial account being identified by an account identifier that enables the merchant to withdraw funds from the account (see paragraph 5 and 10), and enabling credit transactions with the account by a third party based on a credit identifier from which the account identifier cannot be determined (see paragraphs 6 and 7), the credit identifier simultaneously carrying account information capable of identifying the financial account, and transaction information indicating that the transaction in the account is a credit transaction, the account information inseparable from the transaction information in the credit identifier (see paragraphs 5-7). The Examiner recognizes that since the system is only set up to process credit transactions, then when a debit transaction is attempted the system will indicate that debiting is not possible.

Amended claim 20 recites "providing public access electronically to transaction processing parties, of unprotected associations between unique credit-only account identifiers of financial accounts maintained at financial institutions and information that enables the transaction processing parties to forward, safely and without data protection, credit-only transactions toward the financial institutions that maintain financial accounts." There is nothing

in Winig, Wells, or the United Way/CFC system, taken alone or together, that describes or would have made obvious at least this feature of applicant's claim 20. With respect to applicant's understanding of the United Way/CFC system:

1. there is no "public access electronically ... to unprotected associations."
2. even if there were, the associations known to the United Way/CFC are not of "credit-only account identifiers of financial accounts maintained at financial institutions." At most, they are identifiers of charities maintained at one entity, the United Way/CFC.
3. the information provided by a donor to the United Way/CFC is not a credit-only transaction that is to be forwarded toward a financial institution that maintains an account for the charity.
4. the transaction by the donor is not to be effected in the bank account of the charity; rather it is effected in the bank account of the United Way/CFC which then effects a second conventional payment to the charity.

10. As per claim 21,
11. As per claim 22,
12. As per claim 23,
13. As per claim 24,
- ...
14. As per claim 138,
31. As per claim 139,

New claims 140 and 141 have been added.

All of the dependent claims are patentable for at least the reasons for which the claims on which they depend are patentable.

Canceled claims, if any, have been canceled without prejudice or disclaimer.

Any circumstance in which the applicant has (a) addressed certain comments of the examiner does not mean that the applicant concedes other comments of the examiner, (b) made arguments for the patentability of some claims does not mean that there are not other good reasons for patentability of those claims and other claims, or (c) amended or canceled a claim does not mean that the applicant concedes any of the examiner's positions with respect to that claim or other claims.

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The required \$555 Petition for Extension of Time fee is being paid concurrently on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please apply any other charges or credits to deposit account 06-1050, referencing attorney docket 13801-0002001.

Respectfully submitted,

Date: _____

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